

REMARKS

By this amendment, claims 22 and 25 have been amended. Claims 3-6, 9-12, and 15-27 are pending in the application. Applicants reserve the right to pursue the original claims and other claims in this and other applications.

Claim 25 has been amended to correct typographical errors.

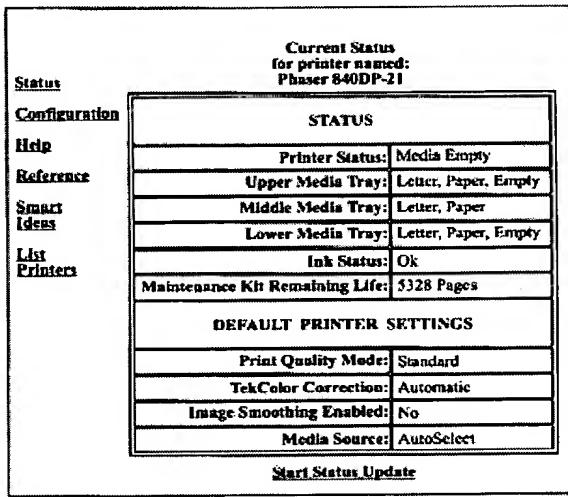
Claim 22 stands rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter and has been amended to address the concerns raised in the Office Action.

Claims 3-6, 9-12, and 15-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Roy et al. (US 6,496,859) in view of Owa et al. (US 6,348,971). This rejection is respectfully traversed. In order to establish a *prima facie* case of obviousness “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. §2142. Neither Roy et al. nor Owa et al., even when considered in combination, teach or suggest all limitations of independent claims 19, 22, or 25.

Claim 19 recites, *inter alia*, a device detecting apparatus comprising “an integrated profile creating unit which integrates ... profiles of ... devices so as to create an integrated profile, said integrated profile being a profile of an ideal virtual device having every function of said devices” (emphasis added). Claims 22 and 25 recite, *inter alia*, “integrating [a] plurality of profiles to create an integrated profile; wherein said integrated profile is a profile of an ideal virtual device having every function of said devices” (emphasis added). Roy et al. does not teach or suggest these limitations.

Conversely, Roy et al. teaches in FIGs. 6 and 7 that the profiles for each printer are maintained separately for each individual printer, and does not teach integration

into a profile of an ideal virtual device. FIGs. 6 and 7, reproduced below. Further, as acknowledged in the Office Action at p. 6, no functions of the printer are included in the profiles in Roy. There is no integrated profile being a profile of an ideal virtual device having every function of said devices. Please note that listing each separate device with associated information on a single display as in Roy FIG. 7 does not meet “creat[ing] an integrated profile, said integrated profile being a profile of an ideal virtual device having every function of said devices” because as shown in Roy FIG. 7, it is listing many different devices, and not a single ideal virtual device.



Roy FIG. 6

View Printer List for printer named: Phaser 840DP-18				
Status	Printer Name	Printer Model	Printer IP Name	Printer Status
Configuration	Art's Chukar	Phaser 740	134.62.90.52	Ready
Help	Art's Chukar II	Phaser 740P	134.62.91.276	Busy
Reference	Audrey's P10031	Phaser 780P	134.62.66.76	Ready
Smart Ideas	Beavtr	Phaser 840DX	134.62.90.181	Ready
List Printers	BO10126	Phaser 840DP	134.62.91.199	Warning Exists
	BO10169	Phaser 840DP	134.62.91.108	Busy
	Chamolis 780	Phaser 780P	134.62.87.213	Warning Exists
	CraAars Running Wild	Phaser 740E	134.62.91.184	Busy
	Dra's Falcon	Phaser 360	134.62.35.30	Ready
	EngUnit1	Phaser 780P	134.62.90.58	Busy
	EngUnit2	Phaser 780P	134.62.90.85	Warning Exists
	EngUnit3	Phaser 780P	134.62.90.237	Warning Exists
	EngUnit4	Phaser 780P	134.62.66.173	Ready
	Firefly	Phaser 350	134.62.91.35	Waiting
	iL-INX SJ1 100-1	iL-INX SJ1 100	134.62.91.243	Error Exists

Roy FIG. 7

Furthermore, Owa et al. teaches “installation location, color/monochrome, print speed, print resolution, paper type, and double-sided print availability are set as the basic information for each of four printers identified as names PRN1 to PRN4 for identifying printers 2a to 2d.” Col. 4, ln. 55-59 (emphasis added). There is no

integrated profile being a profile of an ideal virtual device having every function of said devices. Each of the Owa et al. printer functions are listed separately, and are not integrated in an integrated profile as cited in claims 19, 22, and 25. Thus, Owa et al. does not remedy the deficiency of Roy et al.

Nor does Roy et al. teach or suggest how to modify Owa et al. to obtain the claimed invention. There is therefore no *prima facie* case of obviousness. Obviousness is based on factual findings. "Whether a patent claim is obvious under section 103 depends upon the answer to several factual questions and how the factual answers meld into the legal conclusion of obviousness *vel non.*" *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001). The four underlying factual inquiries are: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 393 U.S. 1, 17-18 (1966).

There is no motivation to combine all of these references to obtain the invention of claim 1. Motivation or suggestion to combine or modify prior art references "must be clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334 (Fed. Cir. 2002). Because the "genius of invention is often a combination of known elements which in hindsight seems preordained," the Federal Circuit requires a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *McGinley*, 262, F.3d at 1351. Yet there is no teaching or suggestion within any of the references that provide a motivation to combine them.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, a showing of an obvious

combination requires more than just an amalgam of references, each of which provides one feature of the claimed invention.

The Office Action has done no more than cite a group of references, each of which provides one feature of the claimed invention, and allege that their combination renders the invention obvious. However, without the benefit of hindsight, there would have been no motivation to combine these references and the Office Action has failed to provide proof of any such motivation.

Since Roy et al. and Owa et al., even when combined, do not teach or suggest all of the limitations of claims 19, 22, and 25, claims 19, 22, and 25 are not obvious over the cited references. Claims 3-6 and 20-21 depend from claim 19 and are patentable at least for the reasons mentioned above. Claims 9-12 and 23-24 depend from claim 22 and are patentable at least for the reasons mentioned above. Claims 15-18 and 26-27 depend from claim 25 and are patentable at least for the reasons mentioned above. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 3-6, 9-12, and 15-27 be withdrawn.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Dated: October 31, 2005

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